

REMARKS

Upon entry of the foregoing amendment, claims 1-4 and 6-13 are pending in the application, with claims 1, 2, and 9 being the independent claims. Claims 1-3 and 9 are sought to be amended. Claim 5 is sought to be cancelled by the present amendment without prejudice to or disclaimer of the subject matter therein.

Claims 1, 2 and 9 have been amended to replace the phrase "a styrene block copolymer (B)" with "a styrene/butadiene/styrene or a styrene/ethylene/butene/styrene block copolymer (B)." Claims 1 and 2 have been further amended to recite that the resin composition is "non-crosslinked, unfoamed and obtained by subjecting to melt plasticization." Support for these amendments can be found in the specification as originally filed, e.g., at page 26, line 24, to page 27, line 15, and in the working examples, at page 37.

Claims 1 and 3 have also been amended to correct obvious typographical errors, e.g., to replace "g/cm3" and "MFR2" with the correct terms "g/cm³" and "MFR₂", respectively. Support for these changes can be found in the specification as filed, e.g., at page 5, line 9.

These changes are believed to introduce no new matter, and their entry is respectfully requested. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Rejection of the Claims Under 35 U.S.C. § 102

Claims 1-7 and 10-13 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 02/14423 to Kuraray Co. ("Kuraray"). (Office Action, at page 2, lines 9-10.) The Office uses US 2004/0092666, the U.S. national stage equivalent of Kuraray, as an English-language translation of Kuraray. (Office Action, at page 2, lines 11-14.)

Claim 5 has been cancelled, rendering the rejection moot with respect to this claim.

With respect to the remaining claims, to expedite prosecution and without acquiescing to the propriety of the rejection, Applicants have amended claims 1 and 2 to replace the phrase "a styrene block copolymer (B)" with "a styrene/butadiene/styrene or a styrene/ethylene/butene/styrene block copolymer (B)," and to recite that the resin composition is "non-crosslinked, unfoamed and obtained by subjecting to melt plasticization." Applicants submit that these claims, as currently presented, are not anticipated by Kuraray.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Kuraray discloses a polymer composition obtainable by subjecting a crosslinkable polymer composition to dynamic crosslinking, the crosslinkable polymer composition comprising:

- (a) a block copolymer comprising two or more polymer blocks A of a vinyl aromatic compound and one or more polymer blocks B of a conjugated diene, the polymer block B being either hydrogenated or unhydrogenated;
- (b) an olefin copolymer having a density of 0.88 to 0.92 g/cm³ and obtained through copolymerization of ethylene and an α -olefin having 4 to 12 carbon atoms;
- (c) a softening agent; and
- (d) an organic peroxide in respective specific amounts (claim 1).

The resin composition of Kuraray is a crosslinked composition that is obtained by subjecting the recited crosslinkable composition to dynamic crosslinking, which is effected by applying heat and shear by melt kneading.

In contrast, Applicants' claimed resin composition is both non-crosslinked and unfoamed. It is then thermally treated without applying shear ("static crosslinking") to obtain a foamed product, as recited in present claim 7.

Thus, Applicants submit that the resin composition disclosed in Kuraray differs from the compositions recited in present claims 1-4, 6, 7, and 10-13. Because Kuraray fails to disclose all elements of these claims, it cannot anticipate the claims. Accordingly, claims 1-4, 6, 7, and 10-13 are novel over Kuraray.

Claims 1-7 and 10-12 are further rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP 001-26663 to Sanwa Kako KK ("Sanwa"). (Office Action, at page 3, lines 5-6.)

Sanwa discloses a damping resin foam that consists of a base comprising a mixture of (i) a copolymer of ethylene and α -olefin having 3 to 18 carbon atoms, and (ii) a tri-block copolymer of polystyrene and vinyl-polyisoprene (claim 1).

Sanwa, however, fails to disclose a resin composition for a foamed product comprising an ethylene/ α -olefin copolymer (A1), a styrene/butadiene/styrene or a

styrene/ethylene/butane/styrene block copolymer (B), and an ethylene/polar monomer copolymer (A2) in a specific ratio, as recited in present claims 1 and 2.

Thus, since Sanwa fails to disclose each and every element of the claims at issue, it cannot anticipate the claims. Accordingly, present claims 1-2, and dependent claims 3, 4, 6, 7, and 10-12, are novel over Sanwa.

Applicants believe that the rejections of claims 1-7 and 10-13 under 35 U.S.C. § 102 have been overcome or rendered moot and requests that these rejections be withdrawn.

II. Rejection of the Claims Under 35 U.S.C. §§ 102/103

Claim 9 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, either Kuraray or Sanwa. (Office Action, at page 4, lines 1-2.)

Specifically, the Office believes that since the compositions disclosed in both Kuraray and Sanwa are substantially identical to the claimed compositions, contain high amounts of crosslinking agent, and are processed at temperatures well above the activation temperature of the crosslinking agent, it is reasonable to believe that the foamed, processed compositions of the references inherently exhibit the gel fraction recited in claim 9. (Office Action, at page 4, lines 7-12.)

Applicants submit that, for the reasons discussed above, both Kuraray and Sanwa fail to disclose the composition of present claim 9, and thus fail to anticipate this claim.

Moreover, as exemplified in working examples of the specification as filed, the claimed foamed product, which comprises the specific styrene block copolymers (B) recited in present claim 9, also possesses low specific gravity and low compression set, excelling in tensile strength and tear strength as well as in impact resilience, and exhibiting less of a decrease in hardness at high temperatures, each of which is not necessarily inherent in, or obvious in light of, the compositions disclosed in the cited references.

Thus, Applicants submit that the product recited in present claim 9 possesses not only novelty but also unobviousness over both Kuraray and Sanwa.

Applicants believe that the rejection of claim 9 under 35 U.S.C. §§ 102/103 has been overcome or rendered moot and request that this rejection be withdrawn.

III. Rejection of the Claims Under 35 U.S.C. § 103

Claim 10 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kuraray. (Office Action, at page 4, line 15.) Specifically, the Office believes that "since the Kuraray reference discloses suitability of the foamed composition for show soles, and also discloses adhesive attachment of the sole to the bottom of the footgear, this embodiment[] makes the claimed laminates at least obvious." (Office Action, at page 4, lines 16-19.)

Claims 10 and 13 are also rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sanwa. (Office Action, at page 5, lines 1-2.) According to the Office, "soles of the disclosed footgear parts of Sanwa would have been obvious for an ordinary artisan," and that "similarly to Kuraray, the claimed laminates would have been obvious as the most common assembly of a shoe sole and the rest of the shoe." (Office Action, at page 5, lines 3-9.)

For at least the reasons discussed above, both Kuraray and Sanwa fail to disclose or render obvious the foamed product used to make the claimed laminates or shoe soles of claims 10 and 13. Thus, one of ordinary skill in the art, in view of either reference, would not have arrived at the claimed laminates and soles. Accordingly, claims 10 and 13 would not have been obvious over either reference.

Claims 8 and 9 are also rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over either one of Kuraray or Sanwa in combination with EP 1229076 ("Mitsui"). (Office Action, at page 5, lines 10-12.) According to the Office, although Kuraray and Sanwa do not disclose processing the foams into a final product via secondary compression of the foams, Mitsui expressly discloses secondary compressing of foams, so that it would have been obvious to form the foamed compositions disclosed by either Kuraray or Sanwa into final products via secondary compression with reasonable expectation of success, since this step is a known step in producing final products from crosslinked polyolefin based foams. (Office Action, at page 5, line 13, to page 6, line 3.)

Applicants submit that present claims 8 and 9 would not have been obvious in light of either Kuraray or Sanwa in combination with Mitsui, because one of ordinary skill in the art, in light of these references, would not have arrived at the claimed foamed products, for at least the following reasons.

As discussed above, an object of Applicants' invention is to provide "a composition which can provide a foamed product (non-crosslinked or crosslinked) having low specific gravity and low compression set (CS), excelling in the tensile strength properties and the tear strength properties, as well as in impact resilience, and exhibiting a less decrease in hardness at high temperatures; a foamed product therefrom; and a laminate using the foamed product," as disclosed at page 4, lines 8-15, of the specification as originally filed. The foamed products or laminates having these excellent physical properties are exemplified in working examples of the specification as filed.

As discussed above, Kuraray and Sanwa disclose resin compositions and products that are much different from those of the invention as presently claimed. Thus, both references fail to disclose each and every element of the claimed compositions. Mitsui, which discloses processing polyolefin foams into a final product via a secondary compression of the foams, fails to cure the deficiencies of Kuraray and Sanwa.

Thus, one of ordinary skill in the art, in light of Mitsui and Kuraray or Sanwa, would not have arrived at the foamed products of claims 8 and 9. Accordingly, claims 8 and 9 would not have been obvious over either one of Kuraray or Sanwa in combination with Mitsui.

Applicants believe that the rejections of claims 8-10 and 13 under 35 U.S.C. 103(a) have been overcome and request that these rejections be withdrawn.

CONCLUSION

Based on the foregoing remarks, Applicant respectfully requests that the Examiner reconsider all rejections and objections and that they be withdrawn. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date January 12, 2009

By Ann E. Summerfield

FOLEY & LARDNER LLP
Washington Harbour
3000 K Street NW, Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

Ann E. Summerfield
Attorney for Applicants
Registration No. 47,982